REMARKS

1. Introduction

In the Office Action mailed June 19, 2008, the Examiner (1) stated that Figures 1, 2, 2a, and 6 should designated by a legend such as "--Prior Art--" and thus were objected to, (2) objected to the drawings under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention specified in the claims, (3) rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement, (4) rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 112, Second Paragraph, as allegedly being indefinite, and (5) rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 102(b) as allegedly being anticipated by Figures 1 and 2 of the present application (referred to as "AAPA" in the Office Action).

2. Status of the Claims

Currently pending are claims 47-66, 71-89, and 92, of which claims 47, 71, and 92 are independent. In order to expedite allowance, Applicant has amended claims 47, 51, 54, 59, 62-63, 71, 74, 76-77, 84, and 92. Applicant submits that none of the amendments introduce new matter.

3. Objections to Drawings

A. Figures 1, 2, 2a, and 6

With regard to Figures 1, 2a, and 6, Applicant has submitted amended drawings herewith in which Figures 1, 2a, and 6 are each labeled as prior art as suggested by the Examiner. Accordingly, Figures 1, 2a, and 6 are in compliance with 37 C.F.R. § 1.121(d). Therefore, Applicant requests withdrawal of this objection to Figures 1, 2a, and 6.

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With regard to Figure 2, Applicant respectfully submits that the illustrated control system is not prior art, and therefore requiring Figure 2 be labeled as such is improper. While Figure 2 was characterized as "conventional" in the Brief Description of the Drawings (p. 9, line 26), Applicant did not intend for the word "conventional" to be interpreted as "known." Rather, in this instance, Applicant intended "conventional" to mean an exemplary system according to the invention. Every other reference to Figure 2 in the specification supports this intent. *See e.g.* Specification at p. 12, lines 13-15 ("Referring now to Figure 2 there is illustrated a typical control system to implement the present invention…"); Specification at p. 15, lines 25-29 ("The control system, for example as illustrated in figure 2, calibrates each device based upon power/frequency measurements obtained at section current combinations within a pre-defined range of currents."). Nonetheless, Applicant has amended the Brief Description of the Drawings to make clear that the control system illustrated in Figure 2 is an exemplary system according to the invention.

In view of the foregoing, Figure 2 is in compliance with 37 C.F.R. § 1.121(d). Therefore, Applicant requests that this objection to Figure 2 be withdrawn.

B. Objection under 37 C.F.R. § 1.83(a)

As noted above, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention specified in the claims. More specifically, the Examiner argued that § 1.83(a) requires that the "drawings must show every feature of the invention specified in the claims." However, 37 C.F.R. § 1.81(a) makes clear that "[t]he applicant for a patent is required to furnish a drawing of his or her invention *where necessary for the understanding of the subject matter sought to be patented.*" (emphasis added) Applicant respectfully submits that the Examiner's interpretation of § 1.83(a) is improper, as it

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implies that every claimed feature must be included in the drawings, *even if it is unnecessary to explain the invention*. Reading § 1.83(a) and § 1.81(a) together, it is clear that § 1.83(a) recites the requirements for drawings *that are necessary to describe the claimed invention*. Thus, Applicant traverses the objection under § 1.83(a).

In this case, the drawings that the Examiner suggests including are not necessary to explain the claimed invention. In particular, the Examiner argues that the "claims describe using a program/process to control a known laser measurement system," but that a "process flow chart that described the claimed process is not illustrated in the drawing." However, including a flow chart that simply mirrors a method or process claim, as the Examiner suggests, is duplicative. Therefore, such flow charts are not necessary to describe the invention, and requiring such flowcharts is improper.

Applicant therefore submits that, as required by § 1.81(a), the drawings include all drawings necessary to understand the claimed subject matter, and that the present drawings comply with § 1.83(a). Accordingly, Applicant requests that the objection under § 1.83(a) be withdrawn.

3. Response to the Rejection under § 112, first paragraph

As noted above, the Examiner rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. In particular, the Examiner stated that the "specification describes several different processes for using the known system of Fig 2 and known laser of Fig 1" and that "[s]ince the system is known in the art the applicant must explain what modification to the system is their invention." However, as discussed above, the system of Figure 2 was not known, nor does Applicant admit Figure 2 is prior art. Thus, Applicant respectfully submits that because Figure 2 is not prior art,

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and because claims 47-66, 71-89 and 92 otherwise comply with the enablement requirement, the § 112, first paragraph rejection should be withdrawn.

More specifically, in an October 20, 2008 teleconference between Applicant and the Examiner, the Examiner stated the Examiner's only basis for considering Figure 2 to be prior art, was the Examiner's conclusion that Applicant admitted Figure 2 to be known prior art in the specification. As Applicant has made clear, Figure 2 was not known, nor has Applicant admitted that Figure 2 is prior art. Therefore, Applicant respectfully submits that the Examiner has not established that Figure 2 is prior art. Therefore, it is improper to require that "the applicant must explain what modification to the system is their invention."

In the context of the above-described rejection, the Examiner also alleged that the claims described processes that were not explained in the specification and that graphs of output data are not readily understood from the descriptions. Based on the context, these statements appear to be part of the § 112, first paragraph rejection that was premised on Figure 2 being prior art. Nonetheless, Applicant submits that the claimed processes are readily understood to those skilled in the art in light of the specification, and that the graphs are easily understood by those skilled in the art based on the descriptions of the graphs in the specification, the graphs themselves, and/or the knowledge of those skilled in the art.

In light of the foregoing, Applicant respectfully submits that the subject matter of the claims is described in the specification so as to enable one skilled in the art to make and/or use the invention. Moreover, the Examiner has not set forth a proper § 112, first paragraph rejection, the rejection is based upon Applicant admitting Figure 2 to be known, which Applicant has not done. For at least these reasons, Applicant requests that the § 112, first paragraph rejection be withdrawn.

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4. Response to the Rejection under § 112, second paragraph

As noted above, the Examiner rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner alleged that the meanings of the limitations "sample index", "normalization" and "effecting a change in relationship between the control currents and the sample index" were unclear. While Applicant respectfully submits that the meaning of these limitations is clear, Applicant has amended the claims in order to better claim the invention and expedite allowance of the application.

In particular, Applicant amended references to "the sample index" to refer to "the *first* sample index." Thus, Applicant submits that this limitation is clear and definite. Moreover, because this limitation is clear and definite, the encompassing limitation, "effecting a change in relationship between the control currents and the first sample index," is also clear and definite. Similarly, Applicant has amended claims to replace the term "the normalization of the output values" with "the *normalizing* of the set of output values," making clear that the action or function of normalizing recited in claims 47, 71, or 92 is being referred to.

For at least the foregoing reasons, Applicant submits that claims 47-66, 71-89 and 92 are clear and definite. Accordingly, Applicant requests that the § 112, second paragraph rejection be withdrawn.

5. Response to the Rejection under § 102(b)

As noted above, the Examiner rejected claims 47-66, 71-89, and 92 under 35 U.S.C. § 102(b) as allegedly being anticipated by Figures 1 and 2 of the present application (referred to as "AAPA" in the Office Action). As explained above, the system of Figure 2 was not known, and Applicant has not admitted that Figure 2 is prior art. Since the Examiner admitted in the October 20, 2008 teleconference that the alleged admission of the Applicant was the only basis

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for concluding Figure 2 to be known, and Applicant does not admit Figure 2 is prior art, the Examiner has not qualified Figure 2 as prior art. Therefore, because Figure 2 is not prior art, Applicant requests the § 102(b) rejection of claims 47-66, 71-89, and 92 be withdrawn.

6. Conclusion

Applicant submits that the present application is in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, the Examiner is invited to telephone the undersigned at any time at (312) 913-3338.

Respectfully submitted,

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